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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,349	12/28/2001	Leon Hurst	004770.00756	5493
22907	7590	02/16/2006	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			ZAND, KAMBIZ	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,349

Applicant(s)

HURST ET AL.

Examiner

Kambiz Zand

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 and 72-83 is/are pending in the application.
- 4a) Of the above claim(s) 35-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19, 22, 25, 28, 31, 34, 72, 73, 75, 76, 78, 79, 81 and 82 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 20, 21, 23, 24, 26, 27, 29, 30, 32, 33, 74, 77, 80 and 83 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/21/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. Applicant's election, without traverse, group I claims 1-34 and 72-83 have been acknowledged. Claims 35-71 have been withdrawn from examination. Please cancel claims 35-71 in response to this office action.
4. **Claims 1-34 and 72-83** have been examined.

Information Disclosure Statement PTO-1449

5. The Information Disclosure Statement submitted by applicant on 08/21/2002 has been considered. Please see attached PTO-1449.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. **Claims 1-15 and 82** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the "uses the content decryption key to decrypt the content" phrases makes the claims indefinite and unclear in that neither means/method nor interrelationship of means/method are set forth in these claims in order to achieve the desired results expressed in the "uses the content decryption key to decrypt the content" phrases. Decryption of the content when no encryption of the content is present in the claim language makes the claim indefinite and unclear.

8. **Claims 2-15** are rejected based on their dependency on the rejected claim 1.
9. In claim 82, the "may be" phrases makes the claims indefinite and unclear in that neither means/method nor interrelationship of means/method are set forth in these claims in order to achieve the desired results expressed in the "may be" phrases. May be is not an affirmative statement or phrase which relate an action may not be taken in the broadest interpretation. Examiner suggests the removal of the phrase "may be".

Double Patenting

10. **Claim 76** is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 75. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in

wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). both claims are identical depending on the same claim (72).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. **Claims 1,2, 6,7, 11, 12, 16, 17, 19, 22, 25, 34, 72,73 and 75-78** rejected under 35 U.S.C. 102(e) as being anticipated by DeMello et al (6,891, 953 B1).

As per claims 1, 6, 11, 16 and 17 DeMello et al (6,891, 953 B1) teach, computer program, program stored on a computer readable medium, terminal of decrypting content stored on a terminal, a method comprising a storage for encrypted content and a license (see col.6, lines 45-47 the DRAM and 53-67) obtaining a license comprising a content decryption key (see col.6, lines 46-53) and a set of binding attributes, the attributes including a public key (see col.6, lines 36-67; col.7, lines 1-2); establishing

communication link between the terminal and at least one other terminal; and receiving digitally signed data on the communication link at the terminal from the other terminal; verifying at the terminal the digitally signed data utilizing the said public key; and wherein the terminal in response to verification of the digitally signed data uses the content decryption key to decrypt the content (see fig.2-4 and associated text; col.11, lines 43-67; col.8, lines 1-6; col.21, lines 36-67; col.22-28; col.33, lines 28-67 disclose all above limitations including certification of the license with user's attributed including the keys, verification of signed certificate; hashing verification to tamperproof the content and communication between the two parties including the decryption of the content by the receiver by decryption key).

As per claims 2, 7, 12 DeMello et al (6,891, 953 B1) teach a method, computer program, program stored on a computer readable medium, terminal as claimed in claims 1, 2 and 7 respectively comprising: encrypting at least the content decryption key (see col.6, lines 38-46 where the decryption key which is the same as encrypted key because they are symmetric keys are encrypted).

As per claim 19 DeMello et al (6,891, 953 B1) teach a terminal as claimed in claim 16, wherein: the digitally signed data is delivered to the storage (see col.6, lines 45-47 and 53-67 DRAM).

As per claims 22, 25, 28, 31 and 34 DeMello et al (6,891, 953 B1) teach a terminal as claimed in claims 16, 19 and 22 respectively, wherein: the network interface issues a request to the other terminal to provide/request the digitally signed data (see fig.2-4 and associated text; col.6-28).

As per claim 72 DeMello et al (6,891, 953 B1) teach a terminal which renders encrypted content comprising: a storage for the encrypted content and a license, the license containing a content decryption key and a set of binding attributes, the attributes including a public key; a protected processing environment; a communication link between the terminal and at least one other terminal which delivers digitally signed data from the other terminal to the terminal; a digital rights management engine disposed in a non-secure part of the terminal; and a digital rights management agent disposed within the protected processing environment which verifies if the digitally signed data is signed by a licensee of the encrypted content and upon verification, uses the content decryption key to decrypt the encrypted content (as applied to claim 1 above; col.6-28; fig.2-4 and associated text where both secure and non-secure environment and transmission and receive of the content by authentication of certificate, digital signature and hashing is being disclosed).

As per claim 73 DeMello et al (6,891, 953 B1) teach a terminal in accordance with claim 72 wherein: the storage is unprotected; and the digital rights management engine decrypts the set of binding attributes to determine if the encrypted content is licensed to

the licensee to be decrypted and if the encrypted content is authorized to be decrypted signals the digital rights management engine to render the content (see fig.2-4 and associated text; col.6-20).

As per claims 75 and 76 DeMello et al (6,891, 953 B1) teach a terminal in accordance with claim 72 wherein: an encrypted part of the license includes a user identity certificate issued and digitally signed by a certification authority which permits a licensor of the content to establish a level of trust in a licensee of the content (see fig.2-4 and associated text and col.6-28).

As per claim 78 DeMello et al (6,891, 953 B1) teach a terminal in accordance with claim 72 wherein: an encrypted part of the license includes a URL which is an address at which a user identity certificate was issued and digitally signed by a certification authority which permits a licensor of the content to establish a level of trust in a licensee of the content (see fig.2-4 and associated text; col.6-28).

Allowable Subject Matter

13. Claims 17-18, 20-21, 23-24, 26-27, 29-30, 32-33, 74, 77, 79, 80, 81 and 83 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. **Claims 3-5, 8-10, 13-15 and 82** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: See enclosed PTO-892
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kambiz Zand
02/11/06
AU 2132

